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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/873,215 06/11/97 HANSON

H 16312P001US

JAMES J MURPHY
WINSTEAD SECHREST & MINICK
5400 RENAISSANCE TOWN
1201 ELM STREET
DALLAS TX 75270

LM02/0323

EXAMINER

TSANG, F

ART UNIT

PAPER NUMBER

274Z

DATE MAILED:

03/23/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08873215

Applicant(s)

Hanson et al

Examiner

Tsang

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-68 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-68 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). cf
- ☒ Notice of References Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Part III DETAILED ACTION

Specification

1. The related application number should be disclosed in the specification.

Drawings

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

3. Claims 18-21, 32-47, 61, 62 and 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 18, the phrase "circuitry for recording all or a portion of the call" is unclear as to what "all of the call" refers to. The term "all of the call" is broadly enough to cover every "things" related to the call that includes the ringing signals of the calls. However, the recited recording circuitry obvious does not record the ringing signals of the call.

Regarding claim 32, the specification only discloses a telephone call/voice processor system interacts with a telephone extension. It is uncertain to the examiner which element of the

specification is referred to by the claimed apparatus. Also, the phrase recited on line 2 "without having to call a resource" is confusing because it is not clear if this phrase describes the apparatus or the telephone extension. Moreover, it is uncertain to the examiner which elements of the specification are referred to by the claimed "downloading the information" and "playing portions of the information". It is further not clear as to why only portions of the downloaded information are played.

Regarding claim 40, lines 5-7, it is uncertain to the examiner which elements of the specification are referred to by the claimed "downloading the information" and "playing portions of the information". It is further not clear as to why only portions of the downloaded information are played.

Regarding claim 61, it is uncertain to the examiner which element of the specification is referred to by the claimed "voice signal originated from a voice mail message".

Regarding claim 62, line 1, "the tactilely initiated activating signal" lacks antecedent basis.

Claims 19-21, 33-39, 41-47 and 65 depend on the rejected claims.

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 1-6, 8-10, 12-21, 23-31, 58-68 are rejected under 35 U.S.C. § 102(e) as being anticipated by Sakurai et al., U.S. Patent No. 5586172 (hereinafter Sakurai).

Sakurai's system reads on the claimed inventions follow:
Sakurai's exchange system includes a switching means (SW1, Fig.1) with a plurality of communication devices (Tel-A to Tel-n, Fig.1), a voice processing means (VMR 6, Fig.1) and a single processing means (it is noted the claimed single processing means includes one or a plurality of elements that includes elements 3, 4 and 5 on Fig.1 of Sakurai).

Regarding the signal processing circuitry as recited in claim 2, the Sakurai's voice detector (23, Fig.9) or the tone detector (column 5, line 40) reads on the claimed circuitry.

Regarding the feature of recording a portion of a call as recited in claim 18, see column 5, lines 38-68 and Fig.4.

Regarding the listening and the recording features as

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recited in claim 58, see column 10, lines 45-68 and Figs.9-10.

Regarding the monitoring feature as recited in claim 66, Sakurai discloses that a user of telephone 7 (see column 5 and Fig.4) can press a button for activating the recording means in the exchange to record a call. In other words, the user can hear [monitor] the message that is generated from the other side of the call and is recorded by the recording means.

6. Claims 32-47 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ohtsuka, U.S. Patent No. 5,815,552.

Ohtsuka discloses an apparatus and a method for providing information (the message that needs to be sent to the called party) to a user (the calling party) comprising:

receiving an activation signal (step S1, Fig.3) from the telephone extension (17 or 20, Fig.1);

coupling the extension to a play channel (Ohtsuka inherently has this claimed limitation because the extension of Ohtsuka automatically receives the output message from the exchange 10, see step S4 on Fig.3);

downloading the information to the play channel from a memory (see S4, Fig.3); and

playing portions of the information (Ohtsuka plays all portions of the message) to the user via the telephone extension (also see columns 1-4).

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7. Claims 40-47 are rejected under 35 U.S.C. § 102(e) as being anticipated by Petty, U.S. Patent No. 5623538.

Petty discloses a method for providing information (multimedia message) stored in a system (system disclosed in Fig.1 or Fig.11) to a user (the message receiver) at a telephone extension (terminal 104, Fig.2) comprising:

receiving an activation signal from the telephone extension (terminal 104, Fig.2 and column 3, lines 14-22);

coupling the extension to a play channel (Petty inherently has this claimed limitation because the terminal 104 of Petty automatically receives the output message from the link 114 of Fig.2);

downloading the information to the play channel from a memory (downloading the stored message from the terminal which stored that message, such as terminal 101, 102 or 103); and

playing portions of the information (voice part of the message) to the user via the telephone extension 104 (Fig.7 and column 9, lines 33-55).

8. Claims 1, 48-57 are rejected under 35 U.S.C. § 102(b) as being anticipated by Matthews et al., U.S. Patent No. 4602129 (hereinafter Matthews).

Regarding claim 1, Matthews discloses a messaging system with voice processing means for storing voice messages and

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control processing means for controlling the messaging system. Matthews's messaging system inherently has switching means controlled by the control processing means because Matthews's messaging system can route an invalid incoming call to an operator with a telecommunication device (see column 68, lines 35-65).

Regarding claims 48-57, Matthews discloses a messaging system which performs all the claimed voice message broadcasting steps. Fig.30 of Matthews discloses the loop for prompting and recording plural addressees. The "Redirect" feature disclosed on Fig.18, column 27, lines 14-38 and column 62, line 33 to column 63, line 45 reads on the claimed feature of broadcasting a voice message to a plurality of mailboxes.

9. Claims 58-65 are rejected under 35 U.S.C. § 102(b) as being anticipated by D'Agosto, III et al., U.S. Patent No.4860339 (hereinafter D'Agosto).

D'Agosto discloses a method comprising listening to a voice at a telephone extension (see the VOX feature, column 11, lines 30-54); activating a recording sequence to record the voice signal; and storing the recorded voice signal in a memory (column 4, lines 7-28, column 10, line 40 to column 11, column 16, column 17, lines 46 to column 18 and column 25). Regarding the preamble of claim 58, the recitation in that preamble has not been given

patentable weight because a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Nevertheless, D'Agosto teaches the switching means (76, Fig.4), the voice processing means (51, Fig.9) and the single control means (70, Fig.9) as recited in the preamble of claim 58.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered

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therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakurai in view of O'Malley et al., U.S. Patent No. 4996707 (hereinafter O'Malley).

Sakurai as applied to claim 3 above differs from claims 7 and 11 in that Sakurai does not teach that the communication device is a fax machine or a modem. However, it was very old and well known in the art that the extension line of a subscriber can be connected to a fax machine or a modem. O'Malley also discloses that the extension line of a subscriber can be connected to a fax machine or a modem. Therefore, it would have been obvious if it is not inherent to one of ordinary skill in the art at the time the invention was made to use the extension line 12 of Sakurai to connect with a fax machine or a modem as taught by O'Malley for the purpose of having multimedia communication services.

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being

unpatentable over Sakurai.

Sakurai as applied to claim 1 differs from claim 22 in that Sakurai does not explicitly teach that the single processing means is a single microprocessor. However, combining a plurality of control features into one processor was old and well known in the art. One skilled in the microprocessor design art can obvious design a microprocessor to perform all features of the control elements of Sakurai. Therefore, it would have been obvious if it is not inherent to one of ordinary skill in the art at the time the invention was made to use a single microprocessor for controlling the exchange. The modification clearly can save space for equipping a plurality of control elements in the system.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Florence et al., U.S. Patent No. 5,712,902 discloses a telecommunications answering feature method and apparatus.

15. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Serial No. 08/873215

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or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-5403 (for informal or draft communications, please label "PROPOSED" or
"DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA.,
Sixth Floor (Receptionist).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fan Tsang whose telephone number is (703) 305-4895. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krista Zele, can be reached on (703) 305-4701. The fax phone number for this Group is (703) 308-5403.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which

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otherwise require a signature, may be used by the applicant and should be addressed to [**krista.zele@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Fan Tsang
Primary Examiner
Group 2742
March 18, 1999

